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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,872	02/20/2004	Thomas R. Bryan	0253-0001	7583

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BEEM PATENT LAW FIRM  
 53 W. JACKSON BLVD., SUITE 1352  
 CHICAGO, IL 60604-3787

EXAMINER

MILLS, DANIEL J

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/783,872	<b>Applicant(s)</b> BRYAN, THOMAS R.	
	<b>Examiner</b> Daniel J. Mills	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/20/2004</u> . | 6) <input type="checkbox"/> Other: ____.  |

*pc*

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a fence module, classified in class 256, subclass 25.
- II. Claim 16, drawn to a method of installing a modular fence, classified in class 29, subclass 284.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II as claimed, are related as product made and process of making. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed in claim 1 can be made by another and materially different process. For example, each of a plurality of fence modules can be connected to one another by the use of short bolts extending through the connector guides that do not extend into the ground. Thus each module would be connected to the next by bolt not extending into the ground. Alternatively, adhesive or welding processes would be used to join modules together, instead of any type of elongated member. Finally, the product of Group I can be made by a process that provides all modules with either straight rows of elongate members, or curved rows of elongate members.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Richard Beem on 7-19-2005, a provisional election was made with oral traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claim 16 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tubular elongate members (claim 4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

In this action it is noted that patent drawings can be relied on to show relative dimensions. In re Hopkins, 342 F.2d 1010, 145 USPQ 140 (CCPA 1965); In re Wolfensperger, 302 F.2d 950, 133 USPQ 140 (CCPA 1962).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowan (US 3,484,081).

As to claim 1, Rowan discloses a fence module for use in a modular fence comprising, a plurality of generally parallel elongate members (11) each having an upper end (about 21a) and a tapered lower end (below 21b), upper (14) and lower (16) crossbars connecting said plurality of elongate members in a row with a pair of end

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members (the first and last 11 in a module made of several of 11) and a plurality of intermediate members (11), wherein said elongate members have a spacing, a connector (14 and 16 are connectors) extending outwardly beyond at least one of said pair of end members for closely connecting said module to another module, said tapered lower ends of said elongate members extending at least about 3 inches (examining the relative distances of figure 5 and reading column 2 lines 21-24 it is clear the elongate members extend at least about 3 inches below the lower crossbar) below said lower crossbar for insertion into ground, said elongate members extending at least about 16 inches above said lower crossbar (examining the relative distances of figure 5 and column 2 lines 21-24 it is clear the elongate members extend at least 16 inches above the lower crossbar).

Rowan fails to disclose that elongate members have a spacing of between about 1 inch and about 2.5 inches. However, Rowan states that "size and spacing is adjustable", column 1 lines 24-27, and that "the fence can be made various sizes for ornamental and decorative landscaping", column 1 lines 52-58. Therefore, it would have been no more than an obvious matter of engineering design choice to one with ordinary skill in the art at the time applicant's invention was made, to modify the fence as disclosed by Rowan to employ elongate members have a spacing of between about 1 inch and about 2.5 inches. This change would have produced no new or unexpected results

As to claim 2, Rowan discloses a fence module according to claim 1, wherein said upper crossbar extends across and covers said upper ends (the area about 21a) of said plurality of elongate members.

As to claim 3, Rowan discloses a fence module wherein the spacing between said elongate members is uniform.

As to claim 6, Rowan discloses a fence module wherein said row of elongate members is generally straight (the modules can be arranged such column 1 lines 39-46).

As to claim 7, Rowan discloses a fence module wherein said row of elongate members is curved (the modules can be arranged such column 1 lines 39-46).

As to claim 8, Rowan discloses a fence module wherein said curved row of elongate members forms an arc (column 1 lines 39-42), but does not specify that this arc is between about 30° and about 90°. However, Rowan states that "the fencing can be erected to follow any type curve or curvatures", column 1 lines 24-27, and that the elements (13) of a module "can be turned at 45° either inward or outward and can also form a circle inward or outward" column 1 lines 39-42. Therefore, it would have been no more than an obvious matter of engineering design choice to one with ordinary skill in the art at the time applicant's invention was made, to arrange the fence elements into modules following an arc between about 30° and about 90°. This change would have produced no new or unexpected results

As to claim 9, Rowan discloses a fence module wherein said curved row of elongate members forms an arc (column 1 lines 39-42), but does not specify that this arc is between about 60°. However, Rowan states that "the fencing can be erected to follow any type curve or curvatures", column 1 lines 24-27, and that the elements (13) of a module "can be turned at 45° either inward or outward and can also form a circle inward or outward" column 1 lines 39-42. Therefore, it would have been no more than an obvious matter of engineering design choice to one with ordinary skill in the art at the time applicant's invention was made, to arrange the fence elements into modules following an arc between about 60°. This change would have produced no new or unexpected results

As to claim 10, Rowan discloses a fence module wherein said module is about 2 feet long (examining the relative distances of figure 5 and reading column 2 lines 21-24 it is clear that a module consisting of two of 13 would be about 2 feet long).

As to claim 11, Rowan discloses a fence module wherein said elongate members extend between about 16 inches and about 24 inches above said lower crossbar (examining the relative distances of figure 5 and reading column 2 lines 21-24 it is clear that the elongate members extend between about 16 inches and about 24 inches above the lower crossbar).

As to claim 12, Rowan discloses a fence module for use in a modular fence comprising a plurality of generally parallel elongate members (11) each having an upper end (about 21a) and a tapered lower end (below 21b), upper (14) and lower (16) crossbars connecting said plurality of elongate members in a row with a pair of end



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members (the first and last 11 in a module) and a plurality of intermediate members (11), wherein said elongate members have a spacing, two pairs of lips (18,19), each pair comprising upper and lower lips, each pair of lips extending outwardly beyond a corresponding one of said pair of end members, each of said pairs of lips providing guides (17) for receiving an elongate stake (11) for connecting each pair of lips to a corresponding pair of lips on another module, wherein said elongate stake includes a tapered lower end for insertion into ground, wherein spacing between said elongate stake and the corresponding end member is the same as the spacing of the elongate members, said tapered lower ends of said elongate members extending at least about 3 inches below said lower crossbar for insertion into ground (examining the relative distances of figure 5 and reading column 2 lines 21-24 it is clear the elongate members extend at least about 3 inches below the lower crossbar), said elongate members extending at least about 16 inches above said lower crossbar (examining the relative distances of figure 5 and reading column 2 lines 21-24 it is clear the elongate members extend at least 16 inches above the lower crossbar).

Rowan fails to disclose that elongate members have a spacing of between about 1 inch and about 2.5 inches and that the spacing between the elongate stake and the corresponding end member is not more than about 2.5 inches. However, Rowan states that "size and spacing is adjustable", column 1 lines 24-27, and that "the fence can be made various sizes for ornamental and decorative landscaping", column 1 lines 52-58. Therefore, it would have been no more than an obvious matter of engineering design choice to one with ordinary skill in the art at the time applicant's invention was made, to

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modify the fence as disclosed by Rowan to employ elongate members have a spacing of between about 1 inch and about 2.5 inches, and spacing between the elongate stake and the corresponding end member not more than about 2.5 inches. This change would have produced no new or unexpected results

As to claim 13, Rowan discloses a fence module wherein said spacing between said elongate members (11) and between said elongate stake (11) and said corresponding end member (the first and last 11 in a module) is uniform.

As to claim 14, Rowan discloses modular fence comprising a plurality of modules (made up of combinations of 11 and 13) each having a plurality of generally parallel elongate members (11) each having an upper end (about 21a) and a tapered lower end (below 21b), upper (14) and lower (16) crossbars connecting said plurality of elongate members in a row with a pair of end members (the first and last 11 in a module) and a plurality of intermediate members (11), wherein said elongate members have a spacing, two pairs of lips (18,19), each pair comprising upper and lower lips, each pair of lips extending outwardly beyond a corresponding one of said pair of end members, each of said pairs of lips providing guides (17) for receiving an elongate stake (11) for connecting each pair of lips to a corresponding pair of lips on another module, said tapered lower ends of said elongate members extending at least about 3 inches below said lower crossbar for insertion into ground (examining the relative distances of figure 5 and reading column 2 lines 21-24 it is clear the elongate members extend at least about 3 inches below the lower crossbar), said elongate members extending at least about 16 inches above said lower crossbar (examining the relative distances of figure 5 and

reading column 2 lines 21-24 it is clear the elongate members extend at least 16 inches above the lower crossbar), wherein some of said plurality of said modules each include a generally straight row of said elongate members (column 1 lines 24-27, 39-42), wherein some of said plurality of said modules each include a curved row of said elongate members (column 1 lines 24-27, 39-42), wherein said elongate stake includes a tapered lower end for insertion into said ground.

Rowan fails to disclose that elongate members have a spacing of between about 1 inch and about 2.5 inches and that the spacing between the elongate stake and the corresponding end member is not more than about 2.5 inches. However, Rowan states that "size and spacing is adjustable", column 1 lines 24-27, and that "the fence can be made various sizes for ornamental and decorative landscaping", column 1 lines 52-58. Therefore, it would have been no more than an obvious matter of engineering design choice to one with ordinary skill in the art at the time applicant's invention was made, to modify the fence as disclosed by Rowan to employ elongate members have a spacing of between about 1 inch and about 2.5 inches, and spacing between the elongate stake and the corresponding end member not more than about 2.5 inches. This change would have produced no new or unexpected results

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowan (US 3,484,081) as applied in claims 1-3 and 6-14, above, and further in view of Nesic (US 6,360,481).

As to claim 4, Rowan discloses a fence module wherein said elongate members are round bars, but does not disclose that they are tubular.

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Nesic (US 6,360,481) teaches the use of tubular elongate members (12) due to cost and weight considerations, and also to hold animal repellent. Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention, to modify the arrangement of Rowan to include tubular elongate members as taught by Nesic for the purpose of reduced cost, reduced weight, and the ability to hold animal repellent.

As to claim 5, Rowan discloses modular fence wherein said module is made from metal, Rowan fails to disclose that the metal used is aluminum.

Nesic (US 6,360,481) teaches the use of aluminum due to considerations of cost, weight, and durability (column 4 lines 33-35). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide Rowan with aluminum as the material for the fence modules as taught by Nesic so as to provide a fence of low cost and weight as well as high durability.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowan (US 3,484,081) as applied in claims 1-3 and 6-14, above, and further in view of Ireland et al. (Ireland - US 4,647,491).

As to claim 15, Rowan discloses the modular fence as claimed except for an anchor brace inserted into the ground, said anchor brace having a cross section that is larger than said elongate stake and said members and at least one lip protruding outwardly from said brace, said lip of said brace including a guide for receiving said elongate stake.

Summers teaches the use of an anchor brace (13) with fencing that is inserted into the ground, said anchor brace having a cross section that is larger than the elongate stake and the members and at least one lip (17) protruding outwardly from said brace, said lip of said brace including a guide (18) for receiving said elongate stake. Summers teaches this is for the purpose of supporting a fencing unit. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention, to provide Rowan with an anchor brace as taught by Summers for the purpose of supporting the fence modules.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brandeis (US 6,182,948), Matt (US 3,701,477), Conde (US 6,622,426), Kazakidis (US D443,698), Campbell (US 4,174,096), Blank (US 1,211,059), Lachman (US 1,236,185), Tabor (US 1,476,853), Everly (US 5,887,856), Holyoak (US 4,301,996), Adelman (US 3,537,687) are cited for pertaining to the modular fencing art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Mills whose telephone number is 571-272-8115. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJM

DJM

7-20-2005

A handwritten signature in black ink, reading "Daniel P. Stodola". The signature is written in a cursive style with a large, looped initial "D".

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600